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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/282,764 | 03/31/1999 | JAY PONTE | GTE-99-808 | 9068 |

32127 7590 06/27/2005

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| EXAMINER |
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CHAMPAGNE, DONALD

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/282,764 | PONTE ET AL. | |
| | Examiner | Art Unit | |
| | Donald L. Champagne | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12, 14-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 26 and 27 is/are allowed.
- 6) ☒ Claim(s) 6-8, 10-12, 14-17, 19-21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 9 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 7 April 2005 have been fully considered but they are not persuasive. The arguments are addressed at para. 7, 9 and 10 below.

Claim Objections

2. Claims 9 and 18 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 26 and 27. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 6-8, 10-12, 14-17, 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being obvious over Herz et al. in view of Kramer et al.
5. Herz et al. teaches (independent claims 6, 15 and 24) a method executed in a computer system, computer program product and apparatus for targeting advertisements, the method comprising: defining at least one category (*cluster*) as containing *target object documents* that may be retrieved (col. 8 lines 48-49 and 58-59); associating at least one supercategory (*cluster*) with multiple categories (*subclusters*) by mapping the multiple categories to the at least one supercategory (col. 7 lines 35-39 and col. 24 lines 12-45); associating an advertisement with *target object X*, the advertisement being separate from the documents contained in the at least one category (col. 39 line 64 to col. 40 line 21); determining at least one term associated with a user search query (col. 56 lines 16-18 or col. 66 lines 41-42); determining a first of said at least one *cluster*/supercategory based on at least one

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term/search profile *P* of said user search query and said multiple *subclusters*/categories of the at least one *cluster*/supercategory (col. 25 lines 1-17); and displaying an advertisement associated with said *target object X* (col. 40 lines 22-24).

6. Herz et al. does not teach associating an advertisement with at least one of said supercategories. Kramer et al. teaches associating an advertisement with at least one of said supercategories (col. 32 lines 24-54, where *illuminations* are ads and the “children’s books” aggregate attribute is the example supercategory with which the *ad/illumination* is associated). Because Kramer et al. presents a simple and economical hierarchical structure for selecting the best ad, while Herz et al. (col. 40 lines 1-21) presents only three general approaches that lack economy (i.e., do not suggest limiting the first choice to a few ads), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Kramer et al. to those of Herz et al.
7. Neither Herz et al. nor Kramer et al. teach forming a banner ad term list. However, Kramer et al. does teach targeting banner ads based on a user’s search request (col. 1 line 67 to col. 2 line 2). Because a “banner ad term list” is the most obvious means for associating a banner ad with search terms (see para. 9-10 below), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a banner ad term list to the teachings of Herz et al. in view and Kramer et al.
8. Herz et al. teaches every feature of the instant invention except associating an ad with a supercategory and the banner ad term list. Herz et al. does teach associating an ad with a target object, i.e., a subcategory, but teaches only three general options for selecting this ad (col. 40, lines 1-21). None of the three options are very helpful. Kramer et al. recognizes this problem of selecting the best ad from many candidates, and suggests that a solution is to first associate an ad with a supercategory. This inherently limits the candidates (to eight in the Kramer et al. example). The solution offered by Kramer et al. is so simple and effective that one of ordinary skill in the art would be compelled to adopt it in place of the ad selection proposals in Herz et al.
9. Note on interpretation of claim terms Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific

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terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". The instant application contains no such clear definition for the phrase "banner ad term list". Hence the examiner is required to give the phrase its broadest reasonable interpretation, which the examiner judges to a set of terms (words) which characterize the banner ad(s).

10. The examiner finds the concept of a banner ad term list to be the most obvious means for relating banner ads to search terms. Indeed, that the examiner cannot think of any other practical means for relating banner ads to search terms. Applicant can traverse this argument by putting forth at least one alternative means for associating banner ads to search terms, and submitting a declaration that applicant believes that one of ordinary skill in the art would have found said alternative to be more obvious than the use of a banner ad term list.
11. Herz et al. also teaches: claims 7, 16 and 25 (col. 68 lines 15-56, where at lines 55-56 FIG. "8", "9" and "10" should respectively be FIG. 7, 8 and 9); claims 8, 17, 10 and 19 (col. 9 lines 63-66 and col. 15 lines 56-67, where *attributes* reads on "additional terms", and said terms/*attributes* are associated with objects as well as queries, and therefore associated with *clusters/categories*); claims 11 and 20 (Fig. 16); and claims 12 and 21 (col. 4 line 54 and col. 26 lines 17-19).

Allowable Subject Matter

12. Claims 26 and 27 are allowed.
13. Allowance is further dependent on successful vetting by a "second pair of eyes", which is required of all allowances to be issued in class 705.
14. The following is an examiner's statement of reasons for the indication of allowable subject matter: the closest prior art, Herz et al. in view of Kramer et al., does not teach or suggest that the documents in said at least one category include business information taken from

listings in at least one directory of businesses. Alberts (US005937392A) teaches targeting ads based on a user searching a business directory for a particular category of business (col. 7 lines 14-18). The result of said search would be a document in at least one category that includes business information taken from listings in at least one directory of businesses. However, the prior art does not teach or suggest that the teachings of Alberts be added to those of Herz et al. and Kramer et al. Alberts teaches serving ads based on categories (e.g., photography or skiing). That fails to recognize the problem identified by Kramer et al. (para. 6 above), so Alberts teaches away from the combination of Herz et al. and Kramer et al.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
18. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
21. The examiner will consider arguments submitted after final with a declaration intended to traverse the rejection argument given in para. 7 and 10 above. Applicant may have other after final arguments considered and amendments entered by filing an RCE.
22. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

22 June 2005